

1631

Docket No.: PA-0028 US

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Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 11, 2004.

By: 

Printed: Jeannie G. Labra

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Olga Bandman

Title: GENES DIFFERENTIALLY EXPRESSED IN VASCULAR TISSUE ACTIVATION

Serial No.: 10/044,090

Filing Date: January 8, 2002

Examiner: Brusca, J.S.

Group Art Unit: 1631

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL FEE SHEET**

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard;
2. Response to Office Communication (3 pp.).

The fee has been calculated as shown below.

☒ X No additional Fee is required.

       Please charge Deposit Account No. **09-0108** in the amount of : \$       0      

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INCYTE CORPORATION



David G. Streeter, Ph.D.

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Date: February 11, 2004

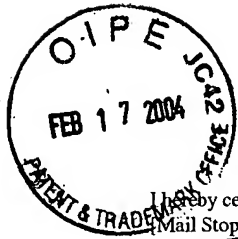
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**RESPONSE TO OFFICE COMMUNICATION**

Sir:

This paper is responsive to the Office Communication, dated February 3, January 22, 2003, setting a 1 month(s) term for response.

In the communication, the Examiner stated that the reply to the Restriction Requirement filed November 28, 2003 was not fully responsive because applicants elected Group 1 and further elected the combination of SEQ ID NOs:1-850 and the combination of SEQ ID NOs:13-15 and 170-179. Applicant is required to elect a single combination of SEQ ID NOs: for the examination of Group 1. The Examiner stated that there is no restriction as to the number of sequences in the combination, however the applicants are requested to provide searching suggestions for SEQ ID NOs that are likely to be novel, since the search burden in determining novelty is large if the combination comprises many sequences.

The Examiner stated further that claims within selected Group 1 (claims 1-9) that do not read on the elected combination of SEQ ID NOs:1-850 will not be examined. Applicants have requested rejoinder of Groups 1 and 2. However, the Examiner stated, Groups 1 and 2 will not be rejoined because they are patentably distinct and have a different search burden since Group 2

requires election of a single SEQ ID NO and that sequence must be searched, whereas the combination of Group 1 could comprise the sequence that would be elected in Group 2 without requiring searching of the Group 2 sequence if another sequence of the Group 1 combination was novel.

Applicants Response

The Examiner apparently misunderstood applicants election, with traverse, of the single combination of SEQ ID NOs:1-850 relative to the examination of Group 1 (claims 1-9).

Applicants pointed out that proper restriction under MPEP § 803.04 in the instant case would require restriction of the application to ten sequences for initial examination purposes relative to both the combination claims of Group 1 and the composition of matter claims to individual sequences recited in the alternative (Group 2, claims 10-13). Applicants therefore also selected the sequences of SEQ ID NOs:13-15 and 170-179 relative to the search of the elected combination of SEQ ID NO:1-850 and the composition of matter claims 10-13.

In accordance with the Examiner's present requirement, applicants reiterate the election of the single combination of SEQ ID NOs:1-850 of claim 1 of Group 1 and suggest the ten sequences of SEQ ID NOs:13-15 and 170-176 relative to the examination of the combination for novelty purposes.

Applicants also reiterate, however, that MPEP § 803.04 states that all of the ten sequences be examined for novelty purposes in this case. Additionally, while the Examiner may withdraw claims from initial examination beyond the elected combination of SEQ ID NOs:1-850, MPEP § 803.04 further requires that:

Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

Thus the final determination of claims of Groups 1 and 2 that may be rejoined and allowed will ultimately depend on the examined sequences of the elected combination.

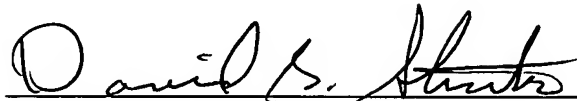
CONCLUSION

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

Date: February 11, 2003



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